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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,485	11/15/1999	PETER SHINTANI	450108-4474	.1116

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EXAMINER

LONSBERRY, HUNTER B

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/242,485

Applicant(s)

SHINTANI, PETER

Examiner

Hunter B. Lonsberry

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12, 14, 15 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12, 14, 15 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Blahut does not teach determining whether said program is a commercial program or a pay program, that the Examiner asserts the Blahut meets this limitation by determining whether a viewer has selected a VOD channel. However, Blahut's VOD channels encompass both the commercial programs and pay programs as defined in the present invention. Hence Blahut is actually making a determination between a VOD channel (commercial/pay programs) and normal TV programming. Blahut does not disclose determining between a commercial program and a pay program within the VOD channel. (amendment pages 5-6)

Regarding applicant's argument, Claims 12 and 15 are completely silent regarding determining between a commercial program and pay program within the VOD channel. The claim merely requires "determining means for determining whether said program is a commercial program or a pay program." Blahut discloses determining what sort of channel a user has selected as well as a desired level of commercial activity (column 6, lines 7-45). As Blahut discloses that different amounts of advertising may be provide with the programming (column 5, lines 61), Blahut must be able to determine which programs are pay segments and which programs are commercial segments.

Applicant argues that Goldhaber does not teach displaying the response request when the commercial program has been viewed in its entirety by the view (response page 6).

The examiner has relied upon portions of U.S. Patent 5,838,314 to Neel to teach this limitation.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 12, 14-15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,532,735 to Blahut in view of U.S. Patent 5,880,720 to Iwafune, U.S. Patent 5,915,243 to Smolen, U.S. Patent 5,838,314 to Neel and U.S. Patent 5,855,008 to Goldhaber.

Regarding claims 12 and 15, Blahut discloses an information receiving device for viewing programs, comprising:

Receiving means (converter at homes 222a-b) for receiving a program for viewing by a viewer (column 3, lines 54-60, column 4, lines 13-22),

determining means (converter at homes 222a-b) for determining whether said program is a commercial program or a Pay Program and displaying the corresponding program to the user (figure 5, step 228, column 6, lines 7-15);

determining if a user desires to watch a different level of advertisements for the pay program, and then crediting the users bill accordingly (column 5, lines 48-65, figure 5, steps 248,250).

said display means (Blahut inherently includes display means as the programs are VOD programs and a converter is present in each home 222) displaying the pay program to the viewer (steps 244, 246).

Blahut fails to disclose, wherein if said program is determined as said commercial program, displaying a response request when the commercial program has viewed in its entirety by the viewer, transmitting a response request from a user associated with the commercial program, adding points to a user account upon receiving the user response, a memory for storing a current points value , a user response and ID corresponding to a commercial program, if a program is a pay program, displaying the current number of points and a points payment request, ad subtracting the corresponding number of points for a pay program.

Iwafune discloses a two way TV system in which TV's communicate with a server associated with a quiz show or interactive catalog (commercial program), when a user submits an answer, the user's television ID and the ID of the currently watched program is attached to the user's response, (column 6, line 38-column 7, line 17, column 8, line 6-column 8, line 67 column 10, lines 5-22, column 11, lines 7-32, Figure 6), thus

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enabling a program provider to learn more about their customers and enabling answers to be cataloged by their corresponding program.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Blahut to utilize the commercial program, requests, responses, commercial ids of lwafune, thereby enabling a program provider to learn more about their customers and enabling answers to be tabulated by their corresponding commercial program.

The combination of Blahut and lwafune fails to disclose displaying a response request when the commercial program has viewed in its entirety by the viewer, the use of a memory for storing a present points value, adding points corresponding to the commercial program to the present points value, and subtracting points corresponding to the pay program in response to a user request.

Neel discloses a Pay Per View and VOD system in which a user may choose whether or not to view an interactive advertisement in order to not be charged for the requested programming, after a user views the advertisements, they are able to interact with the ads which increases the likelihood the user would remember the brand name, provides marketing information and sales leads as well as enabling a user to order products, after which the desired program is transmitted to the user for viewing ( figures 4/7, column 14, line 49-column 15, line 55, column 17, line 34-column 19, line 44).

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Blahut and lwafune, to display the response request after the user has viewed the commercial in its entirety as taught by Neel, for

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the advantage of increasing the likelihood the user would remember the brand name, providing marketing information and sales leads as well as enabling a user to order products.

The combination of Blahut, Iwafune, and Neel fails to the use of a memory for storing a present points value, adding points corresponding to the commercial program to the present points value, and subtracting points corresponding to the pay program in response to a user request.

Smolen discloses in Figure 1, a STB 101 which enables a user to take part in a survey, a user answers question and their responses are stored, in exchange for their responses a number of coupons or promotions (points) are offered to the user and stored in memory via an electronic wallet which may be redeemed at a point of sale (column 4, lines 6-18, column 5, line 1-column 6, line 57, column 7, lines 46-56), thus compensating a user for their time, and encouraging user participation by enabling a user to redeem their points.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Blahut, Iwafune and Neel to utilize the addition of points for completing a survey, as taught by Smolen, in order to compensate a user for their time and increase user participation by enabling a user to redeem their earned points.

The combination of Blahut, Iwafune, Neel and Smolen fails to disclose presenting the number of available points to the user via a display means.

Goldhaber discloses a system which assigns "cybercoins" to a user in response to a user watching advertisements (commercial programs) and then completing a questionnaire afterwards to ensure the user viewed the advertisement, the user may review the number of cybercoins they possess and may utilize the credits to purchase entertainment or other information a user desires to access (column 10, line 65-column 12, line 14, column 16, lines 13-24, column 19, lines 15-21), thus enabling a user to keep track of how much credit they have, and providing an easy way to spend the credits on entertainment.

Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the combination of Blahut, Iwafune, Neel and Smolen, to utilize the credit display, and credit utilization functions of Goldhaber, thus enabling a user to keep track of how much credit they have, and providing an easy way to spend the credits on entertainment.

Regarding claims 14 and 17, Iwafune is relied upon for teaching transmitting the viewer response and commercial ID via a modem 32 (column 6, line 38-column 7, line 17, column 8, line 6-column 8, line 67 column 10, lines 5-22, column 11, lines 7-32, Figure 6).

Goldhaber is relied upon for teaching transmission means for transmitting the present points value (column 10, line 65-column 12, line 14).



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hunter B. Lonsberry whose telephone number is 571-272-7298. The examiner can normally be reached on Monday-Friday during normal business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HBL

